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Hidenori Yamamoto

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TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

CHUMPITAZ, BOB R

ART UNIT

PAPER NUMBER

3629

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/731,928	<b>Applicant(s)</b> YAMAMOTO ET AL.	
	<b>Examiner</b> BOB CHUMPITAZ	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-27 is/are pending in the application.
- 4a) Of the above claim(s) 3, 15-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The following is a Non-Final Office action in response to communication received July 6, 2009. Claims 3 and 15-23 have been cancelled, and claims 24-27 have been added. Therefore, claims 24-27 are pending and addressed below. Amendments to abstract and specification submitted on 7/6/09 are acknowledged.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.1 14, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.1 14, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.1 14. Applicant's submission filed on 7/6/09 has been entered.

#### ***Response to Amendments***

In light of cancellations of claims 3 and 15-23 the previous 35 USC 101 rejection to claims 19-23 are moot; and the 35 USC 112 2<sup>nd</sup> rejections to claims 3 and 15-18 are also moot.

In light of applicant's clarification to the disclosure, the Examiner withdraws the objection to the specification.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Combs et al. (US 7,058,508 B2, hereinafter Combs) in view of Kenji Fujimoto, Shozo Azuma, Masaki Minami, Yasuhiko Miyazaki (JP 2001-195372 A, hereinafter Fujimoto) in further view of Nakanishi et al. (US 200310134634 A1, hereinafter Nakanishi), and in further view of Sameshima et al. (US 6,983,306 B1, hereinafter Sameshima).**

**As per claim 24**, Comb discloses a distributed system in which a plurality of devices are coupled to each other through a network, comprising:

a storage unit (col. 7, lines 14-16 database; Claim 27: machine readable storage);  
a processing unit (col. 3, lines 12-16 data processor); and  
a communication unit (col. 3, lines 3-12 communication network; col. 7, lines 26-32 communication device),  
wherein the storage unit is configured to store a service scenario and a context (col. 3, lines 39-43 maintenance database, service provider database, equipment database, historical database).

Combs discloses the step for maintaining a maintenance database for tracking routine building system maintenance, which indicates a scheduled maintenance event (Abstract;

col. 4, lines 44-56), but does not expressly disclose a service scenario. However, Fujimoto teaches preparing a service scenario [0012], and where service scenarios are retrieved from a service scenario repository with the utilization location of the user a key and the service scenario to be executed is selected from the retrieved service scenarios based on the user information and where the service scenario is executed and the user is provided with the service (Abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the maintenance records of Combs to include a service scenario repository as taught by Fujimoto in order to provide the functions required to perform a specified service.

The Combs/Fujimoto combination discloses the claimed limitation, but do not expressly disclose wherein the service scenario describes functions necessary to provide a service and relationships between the functions, and wherein the context includes area information and selection conditions corresponding to the area information that serve as criteria for selecting one or more devices to be used in providing the service (Combs: col. 1, lines 19-29 building air conditioning systems, smoke detection systems, fire alarm systems, security systems, lighting systems and medical monitoring, each need to be monitored and must be repaired when problems arise and in addition to alarm notification; col. 6, line 67 - col. 7, line 2 control system can be used to monitor the status of each building system in the building and can detect anomalies; col. 4, lines 57-62 selecting a service provider for servicing the building system). However, Nakanishi teaches wherein a service control apparatus implements functions required for providing

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various types of services [0036], and wherein the scenario control layer selects a service scenario in accordance with the contents of the restored information [0059]. In addition Nakanishi teaches wherein the service scenario implementing means implements the service scenario by processing the object selected by the object selection means [0009], and wherein objects which are to be processed when implementing the service scenarios for the respective services, are retained in the service processing equipment [0026]. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the maintenance records of Combs and the service scenario of Fujimoto to include contents of information and functions required for providing services as taught by Nakanishi in order to effectively perform the requested service.

Combs further discloses wherein the processing unit comprises:

an extraction unit being configured to extract the devices necessary for performing the service based on the service scenario (col. 1, line 59 - col. 2, line 4 Bergeron teaches a control system that can access a database of field service engineers designated to provide services to a particular site and establishing communication; see also, col. 3, lines 12-38 the service provider can be selected based on whether the selected service provider is suitable to perform required maintenance and repair; see also Claim 27: computer program having a plurality of code sections executable by a machine to perform the steps of responsive to said detection, automatically selecting a service provider suitable for servicing said building system);

a detection unit being configured to detect available devices located in an area wherein the service can be provided to a requester, each available device having one or more of the functions described as necessary to provide the service according to the service scenario (col. 6, lines 19-25 an automated building service broker can detect in a building system a need for service, either in response to a routine event or error condition; see also Claim 27: computer program having a plurality of code sections executable by a machine to perform the steps of electronically detecting a need for service in a building system in a building site);

a creation unit being configured to create correspondence information specifying a linkage between the detected devices, the correspondence information comprising function information, device information, process information, and data destination information (col. 9, lines 58-64 and Fig. 3, item S18: create work record in historical dB); and

a service execution unit being configured to execute the service for the requester of the service by linking the detected devices based on the correspondence information, wherein the service execution unit allocates a plurality of processes on a single device to different users and executes the service for the different users, the service execution unit being further configured to allocate a data

destination for the service based on the correspondence information when the service execution unit transmits data (Claim 27: computer program having a plurality of code sections executable by a machine to perform the steps of providing an electronic notification of said service need over a communication link to said selected service provider and monitoring said communication link for an electronic response to said electronic notification querying),

The Combs/Fujimoto/Nakanishi combination discloses the claimed limitation, but does not expressly disclose wherein, in response to a change in the area information of the context while the service is executed, the detection unit redetects available devices, and the creation unit rewrites correspondence information on linkage between the redetected devices (Comb: col. 4, lines 23-28 monitoring the communications link for an electronic response to the electronic notification; see also col. 4, lines 41-43 step of detecting a need for service in a building system can include sensing an error condition in the building system; see also col. 5, lines 54-67 responding to an electronic request with an electronic response and transmitting additional geographical positioning data to the automated building service broker after the step of responding; see also col. 6, line 54 - col. 7, line 5 the control system can detect anomalies; see also col. 10, lines 52-55 maintenance database can be updated). However, Sameshima teaches a processing program of devices to deal with changes and updates (col. 1, lines 6-22 a distributed system which is employed in the environment where the state of the surroundings of the control machines or the objects is continuously changed due to



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transfer of a control machine or and object, or a change in a control target; see also, col. 3, lines 16-24 an inter-device cooperative control system and an apparatus therefore in which each device can change its operational conditions; see also, col. 3, lines 35-46 to form a link according to changes in the environment and conditions; see also, col. 12, lines 8-67 when a change occurs in its device conditions, the device sends a conditional change notice, and the device receives this notice, see Fig. 31 and associated text).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the services of Combs/Fujimoto/Nakanishi to include a processing program as taught by Sameshima in order to provide a process that can react to service changes conditions and since system conditions change with time according to the configuration and operational conditions of devices constituting the system.

Comb further disclose wherein the extraction unit extracts the devices by querying a server having a database that stores attribute information of the devices, and selects the devices necessary for performing the service by exchanging information between devices having the functions described in the service scenario (col. 1, line 59 - col. 2, line 4 Bergeron teaches a control system that can access a database of field service engineers designated to provide services to a particular site and establishing communication; see also, col. 3, lines 12-38 the service provider can be selected based on whether the selected service provider is suitable to perform required maintenance and repair; see also col. 6, lines 25-30 building service broker can retrieve a list of service providers suitable for servicing the specified building system; see also col. 8, lines 24-30 server interactions).

**Examiner notes:** A recitation directed to the manner in which a claimed apparatus is *intended to be used* does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform. See MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987). **Please note this also applies to claims 25-27.**

**As per claim 25**, Comb further discloses wherein the detection unit detects the available devices located in the area wherein the service can be provided by acquiring information on the devices extracted by the extraction unit (col. 3, lines 12-38 the automated building service broker can include a Global Positioning System (GPS) data processor for processing the GPS data associated with the communicatively linked service providers, the GPS data corresponding to a geographic position col. 4, lines 41-56 the step of detecting a need for service in a building system can include sensing an error condition).

**As per claim 26**, The Combs/Fujimoto/Nakanishi combination discloses all the elements of the claimed limitation, but does not expressly disclose wherein the detection unit redetects the devices in response to a change in the situation of the devices in the area wherein the service can be provided. However, Sameshima teaches a processing program of devices to deal with changes and updates (col. 1, lines 6-22 a distributed system which is employed in the environment where the state of the surroundings of the control machines or the objects is continuously changed due to transfer of a control machine or and object, or a change in a control target; see also, col. 3, lines 16-24 an inter-device cooperative control system and an apparatus therefore in which each

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device can change its operational conditions; see also, col. 3, lines 35-46 to form a link according to changes in the environment and conditions; see also, col. 12, lines 8-67 when a change occurs in its device conditions, the device sends a conditional change notice, and the device receives this notice, see Fig. 3 1 and associated text). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the services of Combs/Fujimoto/Nakanishi to include a processing program as taught by Sameshima in order to provide a process that can react to service changes conditions and since system conditions change with time according to the configuration and operational conditions of devices constituting the system.

**As per claim 27**, Comb further discloses wherein the creation unit creates the correspondence information for each user requesting a service (col. 6, lines 60-63 upon detecting an anomaly, the control system can request from the automated building service broker corresponding maintenance and repair; see also col. 9, lines 38-63 following the transmission of the work request a work record can be created in a historical database in which historical maintenance records can be tracked) and allocates functions from a single device to different users based on the correspondence information, and releases the functions allocated to each user when the service provided to said each user is completed (col. 2 lines 59-67 control system can access a database of field service engineers designated to provide services to particular remote sites in response to alarm signals received from those sites; see also col. 7, lines 48-53 the service provider database can be consulted to identify a set of approved service providers; see also, col. 9, lines 14-1 8 once a set of suitable service providers has been identified the service providers in the set can be queried to identify a current position for each service provider).

**Please note:**

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

A recitation of the ***intended use*** of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *e.g. In re Collier*, 158 USPQ 266, 267 (CCPA 1968)(where the court interpreted the claimed phrase “a connector member for engaging shield means” and held that the shield means was not a positive element of the claim since “[t]here is no positive inclusion of ‘shield means’ in what is apparently intended to be a claim to structure consisting of a combination of elements.”

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular

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structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) “As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.” *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006)(where the Federal Circuit affirmed the Board’s claim construction of “further including that said wall may be smooth, corrugated, or profiled with increased dimensional proportions as pipe size is increased” since “this additional content did not narrow the scope of the claim because these limitations are stated in the permissive form ‘may.’”).

### ***Response to Arguments***

Applicant's arguments filed on 7/6/09 have been fully considered but they are not persuasive. In the remarks Applicant argues:

#### **New Claims 24-27**

(1) The cited passages of Combs, Fujimoto, and Nakanishi do not disclose or suggest at least the claimed storage, detection, and creation units.

The Examiner respectfully disagrees. Please see rejection above. For clarification reasons, the Examiner cites to col. 4, lines 13-28 of Combs which discloses wherein the automated building service brokering method in accordance with the inventive arrangement can include the steps of electronically detecting a need for service in a building system in a building site (area) or receive input from building site (area) occupant, responsive to the detection, automatically selecting a service provider suitable for servicing the building system, the service provider selected from among a plurality of

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service providers suitable for servicing the building system; providing an electronic notification of the servicing need over a communications link to the selected service provider; and, monitoring the communications link for an electronic response to the electronic notification. As noted in the rejections above, Combs discloses all the structural components of the claimed invention and the cited functions as noted above, i.e. a detection unit performing functions equivalent to the claimed invention.

(2) Nakanishi does not disclose or even suggest a service scenario which describes functions necessary to provide a service and relationships between the functions, nor does the reference disclose correspondence information that specifies linkages between detected devices. Nakanishi does not mention function information, device information, process information, and data destination information.

In response to Applicant's argument (2) the Examiner respectfully disagrees. As cited in the rejection above, Nakanishi does disclose the noted limitation. Paragraph [0008] of Nakanishi recites service scenario retaining means for retaining service scenarios corresponding to respective services to be provided; service scenario selection means for selecting a service scenario for the service associated with the restored information, among the service scenario retained in the service scenario retaining mean; and service scenario implementing means for implementing the service scenario selected by the service scenario selection means. Furthermore, Examiner agrees with Applicant's statement on Pg. 16 of remarks, submitted 7/6/09, that Nakanishi discloses that the detected devices perform one or more of the functions necessary to provide a requested service according a service scenario.

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(3) Applicants respectfully submit that Combs/Fujimoto/Nakanishi fails to disclose or suggest at least "the storage unit stores a service scenario and a context, wherein the service scenario describes functions necessary to provide a service and relationships between the functions...a detection unit being configured to detect available devices...each available device having one or more of the functions necessary to provide the service according to the context...a creation unit being configured to create correspondence information specifying a linkage between the detected devices, the correspondence information comprising function information, device information, process information, and data destination information." Sameshima does not disclose a service execution unit as set forth in claim 24. In particular, Sameshima does not disclose "a service execution unit which executes the service for the requester of the service by linking the detected devices based on the correspondence information, wherein the service execution unit allocates a plurality of processes on a single device to different users and executes the service for the different users."

In response to argument (3) the Examiner has fully considered the argument, but respectfully disagrees. Please see the noted rejections above. In regards to Applicant's argument stating that a person of skill in the art would not be motivated to combine the Combs references with other references, the Examiner points out to MPEP 2143. While there must be some teaching, reason, suggestion, or motivation that the references be combined to arrive at the claimed invention, there is no requirement that the references explicitly suggest the combination. *In re Nilssen*. 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir 1988). The suggestion or motivation to combine the references or

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teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same or similar problem which it addresses. *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979). Furthermore, finding obviousness does not require existence of express, written motivation to combine in prior art, since motivation to combine may be found in nature of problem to be solved leading inventors to look reference relating to possible solutions to that problem. *Ruiz v. A.B. Chance Co.*, 69 USPQ2d 1686 (CA FC 2004). Additionally, the Courts have made clear that the teaching, suggestion, or motivation test is flexible and an explicit suggestion to combine the prior art is not necessary. The motivation to combine may be implicit and may be found in the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *Id.* at 1366, 80 USPQ2d at 1649. MPEP 2143 (G).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BOB CHUMPITAZ whose telephone number is (571)270-5494. The examiner can normally be reached on M-TR: 7:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN WEISS can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-270-6494



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B. C.  
Examiner, Art Unit 3629

/JOHN G. WEISS/  
Supervisory Patent Examiner, Art Unit 3629